

### **REMARKS**

Entry of this response is proper under 37 CFR §1.116, since no new issues or claims are presented.

Claims 1-30 are all the claims presently pending in the application.

It is noted that the claim amendments, if any, are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 14-23 stand rejected under 35 U.S.C. § 101 as allegedly directed toward non-statutory subject matter.

Claims 1-30 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,298,356 to Jawahar et al.

These rejections are respectfully traversed in the following discussion.

#### **I. THE CLAIMED INVENTION**

As exemplarily defined in, for example, independent claim 1, the claimed invention is directed to a method of enhancing a dialog with a web server. The dialog state is determined by comprehensively capturing a dialog with the web server.

As exemplarily further defined in, for example, independent claim 30, the method of the present invention for enhancing a dialog with a web server includes comprehensively capturing a dialog with said web server by: setting up an intermediary when a user contacts the web server; modifying URLs sent by the user so as to route requests of the user to the intermediary; and modifying URLs sent by the web server so as to route to the intermediary the responses of the web server to the requests, thereby allowing the intermediary to capture all requests and responses of the dialog.

Conventional methods related to the present invention, as described beginning at line 16 on page 17, possess a deficiency of being unable to comprehensively monitor a dialog between a user and a web site, particularly as the user meanders to other unrelated web sites.

The claimed invention, on the other hand, sets up an intermediary so that all dialog requests and responses are redirected to that intermediary before being forwarded. This

interception of the entire dialog allows the contents of the dialog to be analyzed to determine a state of the dialog, including a mental state of the user. This comprehensive capture capability was not possible in conventional methods of dialog monitoring.

## II. THE 35 USC §101 REJECTIONS

The Examiner considers that claims 14-23 are directed to non-statutory subject matter. More specifically, the Examiner considers that claim 14-18 are non-statutory because of a "software, *per se*" standard and that claims 19-23 are non-statutory because of a "signal-bearing medium" standard.

In response, Applicants again point out that claims 14-18 are directed to an "apparatus", which places it within one of the four categories specifically itemized in 35 USC §101. Applicants further respectfully submit that there is no "software, *per se*" test for statutory subject matter and again request that the Examiner cite a specific holding providing such test so that the facts of that case can be distinguished and so that Applicants can obtain a precise understanding of this new test for statutory subject matter.

In the final paragraph on page 11 of the Office Action, the Examiner declares: *"Claims 14-23 are directed to an "apparatus" does not make them statutory because according to the specification the apparatus can be a software."* Although it is not certain what point exactly the Examiner is attempting to make by this statement, it is brought to the Examiner's attention that no case law holding that Applicants are aware would support this statement. Accordingly, Applicants again request that the Examiner provide a case law citation supporting this authority to simply ignore the plain meaning of the claim language and to summarily declare that anything involving software is non-statutory.

Relative to claims 19-23, Applicants similarly submit that there is no "signal-bearing medium" test for statutory subject matter and again request that the Examiner cite a specific case holding so that the facts of that case can be distinguished and the test understood. In the present application, these claims are clearly stated as being directed to a *"signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform a method of enhancing a dialog with a web server."*

As such and as would be interpreted by one having ordinary skill in the art, these claims are directed to at least a memory (e.g., a hard drive, ROM, or RAM) in a computer storing these instructions either as a potential program to be executed or a program actually

being executed or to a standalone diskette containing instructions for the method of the present invention.

This latter interpretation is clearly protected under the holding of *In re Beauregard*, 53 F.3d 1583 (1995), wherein the Commissioner conceded to the Court of Appeals that such diskettes were statutory subject matter. US Patent No. 5,710,578 to Beauregard et al, issued on January 20, 1998.

The former interpretation involves memory of a computer, which is hardware and would also clearly be protected either as one of the four categories itemized in 35 USC §101 or as a product of manufacture.

Moreover, the claims are also clearly directed to a sequence of steps, thereby indicating a process, one of the four categories specifically itemized in 35 USC §101.

In view of the foregoing, the Examiner is again respectfully requested to reconsider and withdraw these rejections or to provide a citation of case law holding that explains the details of these new tests for statutory subject matter.

### III. THE PRIOR ART REJECTION

The Examiner alleges that Jawahar teaches the claimed invention. Applicants continue to disagree, particularly since Jawahar does not use an intermediary, as that term is defined in the specification at line 16 of page 12 through line 16 of page 13. Nor does Jawahar have the capability of comprehensively capturing the whole dialog as that terminology is described at lines 9-12 of page 13, including the user's meandering to other web sites.

Jawahar discloses a method (see Figure 1 and lines 27-34 of column 4) in which a Java applet and JavaScript method are downloaded to a user's computer when the user contacts a server (lines 4-27 of column 11). The method monitors which pages from the server the user accesses (Figure 7A), including a monitoring of amount of time (Figures 7B & 8). From this monitoring, the method determines whether to present a "help" icon (step 262 of Fig. 8) so that the user can obtain assistance, if desired. If the user does select "help", this request is directed to a server that forwards the request to an agent (Figure 9), who will then enter into a dialog with the user (step 610 of Fig. 13, step 710 of Fig. 14).

This method of Jawahar is clearly different from that of the claimed invention, even if there are some similarities in some aspects. It clearly fails to use an intermediary and clearly

fails to comprehensively capture the entire dialog.

In particular, as illustrated perhaps best by the amendments to claim 30, the present invention uses a method quite different from that of Jawahar wherein Java components are downloaded from the server to the user's computer. The method of Jawahar allows a monitoring of only the accesses made by the user from that server, and the closest that Jawahar's method comes to determining a "state" of the dialog with the server is the use of timer modules measuring the time the user spends on a page.

In contrast to Jawahar, the present invention sets up an intermediary and causes all user requests and all server responses to be redirected through this intermediary (e.g., proxy server). As explained on pages 12 through 16, this method is based on the assignee's Web Intermediaries (WBI) component, which allows an intermediary to be placed into the request and response streams of the user, thereby providing a dialog capture capability not previously available, including a method to capture the user's state. This redirection technique also permits meanderings to other web sites to be captured, thereby providing a comprehensive capture of the dialog as it progresses to other web sites.

Thus, in contrast to the method of Jawahar, wherein a module is downloaded and installed in the user's browser to monitor only the user's accesses to web pages of that web site, the present invention monitors the streams of both the user's requests and the server's responses. This dialog monitoring is, therefore, more comprehensive than that being done in Jawahar, particularly in view of the capability of the present invention to continue the dialog monitoring even when the user meanders away from the web site to check out other web sites for additional information. Jawahar's method does not offer this comprehensive dialog monitoring capability, as this term is described in the specification, even if the time monitoring of Jawahar's method is broadly interpreted as providing an analysis of the state of the dialog.

Hence, turning to the clear language of the claims, in Jawahar there is no teaching or suggestion of: "... determining a dialog state by comprehensively capturing a dialog with said web server", as required by independent claim 1. The remaining independent claims have similar language.

Moreover, relative to the rejection of record for claims 3-5, Applicants submit that the only analysis done in the method of Jawahar is that of monitoring the times spent on the various pages accessed, which analysis fails to reasonably satisfy the plain meaning of the claim language of these claims. The only other analysis in Jawahar is that of determining the

best agent to rely upon, but this analysis is not reasonably described as being a determination of the state of the dialog itself. Relative to claim 5 specifically, Jawahar fails to suggest using natural language processing capability.

Relative to the rejection for claims 6 and 7, as explained above, the method of Jawahar is based upon downloading Java components to the user's browser. There is no suggestion in Jawahar to use an intermediary, as this term is discussed in the specification of the present application and understood as a term of art by persons of skill in the art.

Relative to the rejection for claims 11, 13, and 18, there is no suggestion in Jawahar that the user's dialog with the original server would be continued if the user moved to another unrelated server.

Relative to the rejection for claims 25 and 26, written in means-plus-function format, Jawahar fails to reasonably teach or suggest using a method having the means described in the present application or any reasonable equivalent. Therefore, these claims are clearly patentable over Jawahar.

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggest by Jawahar. Therefore, the Examiner is respectfully requested to withdraw this rejection.

#### **IV. FORMAL MATTERS AND CONCLUSION**

In view of the foregoing, Applicants submit that claims 1-30, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 10/728,864  
Docket No. YOR920030319US1

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



Date: April 14, 2008

---

Frederick E. Cooperrider  
Registration No. 36,769

**McGinn Intellectual Property Law Group, PLLC**  
8321 Old Courthouse Road, Suite 200  
Vienna, VA 22182-3817  
(703) 761-4100  
**Customer No. 21254**

**CERTIFICATION OF TRANSMISSION**

I certify that I transmitted via EFS this Request for Reconsideration under 37 CFR §1.116 to Examiner U. Cheema on April 14, 2008.



Frederick E. Cooperrider  
Reg. No. 36,769